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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,837	03/06/2002	Yasuo Mori	00862.022538	5805
5514	7590	10/19/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			QIN, YIXING	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2622	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,837

Applicant(s)

MORI ET AL.

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/1/02, 6/6/02.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-40 are rejected under 35 U.S.C. 101 because

(A) The mentioned claims format is unacceptable and subject to a 101 rejection:

"A computer program product for performing the steps of ..."

Such a claim is non-statutory because the terminology "computer program product" alone has no set definition.

(B) The following claim formats are acceptable and not subject to a 101 rejection:

"A computer program embodied in a computer readable medium for performing the steps of ..."

"A computer readable medium storing a program for performing the steps of..."

A statutory product with descriptive material must include a positive recitation of the computer readable medium -- MPEP 2106, case law, USPTO policy, all are founded on this.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4, 14 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims relate to the fact that an user can designate an upper or lower

Art Unit: 2622

surface without the mediacy of a GUI. However, there is no explanation as to how this is implemented – the Examiner just assumes this is a simple interface (i.e. a control panel) with buttons and lights and no actual LCD display.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-5, 8, 9, 11-15, 18, 19, 21-25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourdeau'Hui et al (U.S. Patent No. 5,995,719 – "Bourdeau'Hui").

1. Claims 1, 11 and 21

- Bourdeau'Hui discloses in column 3, lines 6-11 a program for setting up the positioning and information of sheets to be printed
- Bourdeau'Hui discloses in column 6, lines 65-67 and 7, lines 1-13 that there are a "recto" (i.e. **upper**) and "verso" (i.e. **lower**) sides in which to print pages. Although a determination is not explicitly disclosed, the program would need to know the "recto" and "verso" sides in order to output the sheets properly. Lines 5-8 of column 7 discloses that the reason for placing the pages in a certain order and some to be turned upside down is to have the proper **page order** so that the two sides match each other. Please also note Fig. 3 for an example of sheets created through an imposition process.

2. Claims 2, 12 and 22

- Bourdeau'Hui discloses in column 6, lines 31-37 that automatic two sided printing is the optimal case. As mentioned above in claim 1, the program would have to

Art Unit: 2622

know which side is which automatically in order to properly automatically print the sheets in the right page order.

3. Claims 3, 13 and 23

- Bourdeau'hui discloses in column 8, lines 1-30 that a processing that an user can designate is the number of pages in a section and/or pages to be printed on a layout. Although the Fig. 3 shows 8 pages per sheet, one of ordinary skill knows that this number can be set to another amount – see Fig. 5. The motivation would be to enable an user to print larger images that are easier to see or smaller images to save paper.

4. Claim 4, 14 and 24

- Although not explicitly disclosed, the designation without a GUI would simply mean an interface (such as a control panel) with available “upper” and “lower” surface button without a display, such as an LCD screen. Printers, for example, without displays are conventional and one of ordinary skill would know how to assign functionality (i.e. upper and lower surface selection) to the buttons on the printer.

5. Claim 5, 15 and 25

- Bourdeau'hui discloses in column 7, lines 52-67 that different layouts on a sheet can be made depending on how many pages a user wants on the sheet of printed material (i.e. **the specific type of sheet** has, for example, 1 or 2 pages, which determines the layout of the sheet). Lines 60-67, discloses the folding of the sheets to create the final product, so it would be obvious to one of ordinary skill that changing the layout (e.g. the placement of the pages on the sheet) would adverse affect the final product in that the pages will not line up after the folding process.

6. Claims 8, 18 and 28

- Bourdeau'hui discloses in column 11, lines 3-13 the positioning of the “spine,” which is used for folding. Although not explicitly disclosed, one of ordinary skill in the art understands that this spine area is not to be printed up for the purposes of Bourdeau'hui's invention, i.e. it is a part of the page that already has a predefined use. Therefore, the layout, as one see in Figs. 3 and 5, that the setting of the areas of the pages are consistent and does not include the spine area.

7. Claim 9, 19 and 29

- From claim 8 above, one can see in Figs. 3 and 5 that the various sheets are arranged in the same fashion (i.e. a second sheet's layout is set just the same as the layout of the first sheet).

Art Unit: 2622

II. Claims 6, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourdeau'Hui et al (U.S. Patent No. 5,995,719 – "Bourdeau'Hui") in view of Hanzawa (U.S. Patent No. 5,506,661)

8. Claim 6, 16 and 26

- Bourdeau'Hui discloses in column 8, lines 50-56 that "marks" are added for checking correct placement and version control. Bourdeau'Hui does not explicitly disclose the charging for particular sheet sizes. However, the secondary reference, Hanzawa, discloses in Fig. 2 a printing machine capable of charging depending on the size and quantity of paper chosen. Both references are in the art of printing materials of different sizes or layouts. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to simply implement a calculation mechanism for charging for sheets. The motivation would be to allow the machine to make money and to prevent users from printing large amounts of pages.

III. Claims 7, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourdeau'Hui et al (U.S. Patent No. 5,995,719 – "Bourdeau'Hui") in view of the applicant's admitted prior art.

9. Claim 7, 17 and 27

- Bourdeau'Hui does not explicitly disclose the type of sheet used. However, 2 X 2 postcards are disclosed by the applicant to be conventional on page 1 of the specification.

IV. Claims 6, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourdeau'Hui et al (U.S. Patent No. 5,995,719 – "Bourdeau'Hui") in view of Holt (U.S. Patent No. 5,495,561)

10. Claim 10, 20 and 30

- Bourdeau'Hui does not explicitly disclose the spooling of data in his invention. However, spooling is a conventional technique in the art of printing and the claim describes steps that are known in spooling. The Holt reference discloses such a technique in column 9, lines 64-67 and column 10, lines 1-15.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ


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